

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/566,334	Applicant(s) CHELLAPPA ET AL.	
	Examiner MARIANNE L. PADGETT	Art Unit 1715	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 31 December 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☒ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: _____.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
 13. ☐ Other: _____.

/Marianne L. Padgett/
 Primary Examiner, Art Unit 1715

Continuation of 3. NOTE:

(1) Applicants have informally added limitations from claims 4, 11 & 13 to the independent claim, thus creating a combination of requirements not previously combined in the process, as well as these previous dependent claim limitations combination with depending claims with which they were not previously associated.

(2) In claim 1, as inserted into the process it is uncertain whether "subjecting said coating to thermal processing" is performed after forming the hydrogen separation membrane, or if it is supposed to be part of the process of that formation, since the preceding "wherein" & "thereby" statements imply the coating already has the required properties before the thermal processing, however depending claims 14 includes the thermal processing as part of forming the claimed membrane.

(3) Independent product claim 29 has the informally added limitation of "wherein said coating is subject to thermal processing" which creates the new issue of what if any necessary structure generic thermal processing of the previously claimed structure & coating requires in the claimed product (e.g. hydrogen separation membrane).

(4) Applicants have amended dependent claims 8 & 33 to specify what is & isn't allowed to diffuse through the claimed "diffusion barrier", which while correcting clarity issues, creates new issues with respect to what properties are necessarily required to be present.

(5) Similarly, while the amendment to claim 27 clarifies the meaning of a relative term by providing specific range limitations for partial pressure of oxygen, the new range creates a new issue not previously considered.

Continuation of 5. Applicant's reply has overcome the following rejection(s):

The proposed amendments appear to correct objections to the claims due to dependence issues, as set forth in section 2 of the action mailed 12/16/10; as well as clarity issues as set forth in section 3 thereof; plus if paragraph #'s are corrected, the objection to the disclosure as set forth in section 4 would also be removed.

Continuation of 11. does NOT place the application in condition for allowance because:

While applicants have provided new issues in the claims with respect to combinations of dependent claim limitations that were not previously required to be considered together, the individual limitations that have been added to the claims were previously considered & rejected over prior art, so while further review of the applied art is needed to ascertain if the proposed combination of previously considered limitations provides any significant distinguishing features as combined with respect to the prior art, a generic thermal processing to produce unstated &/or uncertain results is not likely to provide patentable significance.

Also, the proposed claims also provide new scope issues requiring further consideration, with respect to the product, which new limitations of a process requirement in the independent product claim does not have readily apparent structural implications, thus need significant further review & consideration.

Furthermore, there are new clarity issues as mentioned above, as well as amendment noncompliance problems.

/MLP/dictation software

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